

I hereby certify that this correspondence is being filed via
EFS-Web with the United States Patent and Trademark Office
on February 14, 2008

PATENT
Attorney Docket No. 026595-005900US

TOWNSEND and TOWNSEND and CREW LLP

By: / Stephanie Klepp /
Stephanie Klepp

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Mark Thompson, et al.

Application No.: 10/032,796

Filed: December 26, 2001

For: FORMS AUDITING SYSTEMS
AND METHODS

Confirmation No. 7212

Examiner: JACOBS, LASHONDA T.

Technology Center/Art Unit: 2157

APPELLANTS' BRIEF UNDER
37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal mailed on December 17, 2007 for the above-referenced application, Appellants submit this Brief on Appeal.

TABLE OF CONTENTS

1. REAL PARTY IN INTEREST	3
2. RELATED APPEALS AND INTERFERENCES	3
3. STATUS OF CLAIMS	3
4. STATUS OF AMENDMENTS	3
5. SUMMARY OF CLAIMED SUBJECT MATTER	3
6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	4
7. ARGUMENT	5
8. CONCLUSION	8
9. CLAIMS APPENDIX	9
10. EVIDENCE APPENDIX	12
11. RELATED PROCEEDINGS APPENDIX	13

1. REAL PARTY IN INTEREST

At the time of the filing of this Appeal Brief, The Western Union Company is the real party in interest for this appeal.

2. RELATED APPEALS AND INTERFERENCES

An Appeal Brief was filed in this Application on March 14, 2007. In response thereto, the Office reopened prosecution with a new Office Action mailed July 16, 2007 ("Office Action"), specifying a new grounds of rejection.

No other appeals or interferences are known which will directly affect, are directly affected by, or have a bearing on the board decision of the pending appeal.

3. STATUS OF CLAIMS

Claims 1-15 were originally filed in the application on December 26, 2001. Claim 16 was added by Amendment dated June 6, 2005. Claims 1-16 stand rejected by the Examiner.

Claims 1-16 are believed improperly rejected and are the subject of this Appeal. A copy of the claims as rejected is attached as an Appendix.

4. STATUS OF AMENDMENTS

All Amendments have been entered. No amendments have been filed subsequent to the Final Office Action mailed November 15, 2006 ("Final Office Action").

5. SUMMARY OF CLAIMED SUBJECT MATTER

In the following summary, Appellants have provided references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. §41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, these references are intended to be illustrative in nature only. Claims 1, 11, and 16 are the independent claims.

Claim 1 recites a method for auditing forms. The method includes issuing a request to provide a form identifier that is associated with a form. Original Application, p. 4, ll. 18-24; p. 5, ll. 9-11. The identifier is then received at a host computer. Id., p. 5, ll. 10-12. The host computer verifies whether the identifier is a valid identifier for the form being used. Id., p. 4, ll. 22-23; p. 5, ll. 10-12.

Claim 11 recites a forms auditing system that includes a host computer 12 associated with a database 14. Id., p. 3, ll. 21-25; Fig. 1, ref. nums. 12, 14. The database has a record of a set of forms and a valid identifier for each of the forms. Id., p. 4, ll. 17-23. The host computer is configured to receive an identifier in response to a request to audit a form. Id., p. 4, ll. 18-23; p. 5, ll. 9-12. The host computer verifies whether the identifier is a valid identifier for the audited form by comparing the identifier with the identifiers in the database. Id., p. 4, ll. 22-23. A record is produced in the database of the comparison. Id., p. 5, ll. 14-16.

Claim 16 recites an alternative forms auditing system that includes a host computer 12 associated with a database 14. Id., p. 3, ll. 21-25; Fig. 1, ref. nums. 12, 14. The database has a record of a set of forms and a valid identifier for each of the forms. Id., p. 4, ll. 17-23. A form identifier is associated with a form. Id., p. 4, ll. 17-23. The host computer is configured to receive an identifier in response to a request to audit a form. Id., p. 4, ll. 18-23; p. 5, ll. 9-12. The host computer verifies whether the identifier is a valid identifier for the audited form by comparing the identifier with valid identifiers in the database. Id., p. 4, ll. 22-23. A record is produced in the database of the comparison. Id., p. 5, ll. 14-16.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Ground of Rejection I: Claims 1, 6, 11-14, and 16 stand rejected as anticipated under 35 U.S.C §102(e) by U.S. Patent No. 6,600,482 to Leone, Jr. et al. ("Leone"). Pages 2-4 of the Office Action describe the Examiner's current position on this issue.

Ground of Rejection II: Claims 2-3, 5, and 15 stand rejected as unpatentable over Leone in view of U.S. Pub. No. 2006/0012473 to Bishop et al. ("Bishop"). Pages 4-5 of the Office Action describe the Examiner's current position on this issue.

Ground of Rejection III: Claims 4 and 7-10 stand rejected as unpatentable over Leone in view of U.S. Pat. No. 5,799,285 to Klingman et al. ("Klingman"). Pages 6-8 of the Office Action dated July 16, 2007, describe the Examiner's current position on this issue.

7. ARGUMENT

Ground of Rejection I:

35 U.S.C. §102(b) rejection of claims 1, 6, 11 and 16

The Office Action rejected independent claims 1, 11 and 16 under 35 U.S.C. §102(e) as anticipated by Leone. For a valid anticipation rejection, the Office must show that each limitation from the claims appears in a single piece of prior art. Appellants believe significant limitations from independent claims 1, 11, and 16 are neither taught nor suggested in the references. More specifically, the references cannot be relied upon to teach or suggest 1) "receiving an identifier in response to a request to audit a form" or 2) "verifying whether the form identifier is a valid form identifier for the form to be audited," as recited in claim 16. Similar limitations are also found in both independent claims 1 and 11.

The independent claims each set forth a system or method for auditing whether a particular form is valid (e.g., checking to see if the updated or current version of a form is being used). By way of example, the process may be initiated with a request to audit a form (e.g., made by issuing a request to provide a form identifier associated with a form). Then, as claims 11 and 16 specifically recite, a host computer "receives an identifier in response to the request ... [and verifies] whether the form identifier is a valid form identifier for the form to be audited by comparing the form identifier with the valid form identifiers in the database." Claim 1 includes a similar limitation.

The Office Action errs in relying on Leone to teach these limitations. Office Action, pp. 2-3, sec. 2, citing Leone, col. 7, ll. 46-65; col. 8, ll. 1-10. Unlike the claims, the Leone reference instead describes a system for automatically recognizing forms based on the location of a mark on the form. Leone, Abstract, col. 2, ll. 34-40; col. 6, l. 28 - col. 7, l. 62. Leone's process of first identifying a pre-printed form, and subsequently recognizing writing

thereon, is different than a determination whether a particular version number (e.g., a form identifier) is a *valid* identifier for the particular form being used.

More specifically, Leone describes "a method for automated identification of pre-printed forms, comprising the steps of identifying the existence and location of a mark made manually on a pre-printed form and identifying the pre-printed form by comparing the location of the mark to a database listing forms and corresponding locations of identifying marks. ... [Leone also describes] a system ... that receives one or more digitized images of marks made on the form, identifies the existence and location of one or more identifying marks made by the user, and identifies the form by comparing the location of said one or more marks to a database listing forms and corresponding locations of identifying marks." *Id.*, col. 2, ll. 34-50.

Leone, therefore, describes a process of identifying a form type by looking up the form (e.g., in a forms database) based on the location of the mark on a scanned version of the form (*Id.*, col. 7, ll. 50 - 54). A form type may be identified in the database by a particular "form ID number." Then, knowing the layout of the form type being used, the ink data from the form is recognized (e.g., using optical character recognition; *Id.*, col. 7, l. 63 - col. 8, l. 4). The recognized writing may then be "audited, verified, and corrected" by a user. *Id.*, col. 8, ll. 8-10. While this clearly differs from the claims at issue, there is limited or no analysis of how these very different processes relate to the present claims; instead, there are merely citations.

The Office erred by asserting that the pre-printed form identification and writing recognition process of Leone teaches the forms auditing system of the claims. The audit of the claims determines whether there is a *valid* form identifier. The term "audit" recited in Leone is an optional user check of automatically recognized writing on a pre-printed form. The identification of a pre-printed form and subsequent techniques for identifying writing thereon clearly differs from the determination of whether a particular version of a form is *valid*. The determination of form type in order to better recognize the writing thereon differs from a determination of *validity*.

The request to audit the validity of a form, and the response thereto, are simply not present in Leone. Leone therefore fails to teach, "receiving an identifier *in response to a*

request to audit a form," as recited in claim 16. Moreover, Leone fails to teach "verifying whether the form identifier is a valid form identifier for the form to be audited," as recited in claim 16. Similar limitations are found in claims 1 and 11, and thus are also absent from Leone.

As the cited reference fails to teach or suggest all of the recitations of independent claims 1, 11, and 16, Appellants submit that these claims are allowable. Claim 6, which depends from these independent claims, is allowable for at least the same reasons. Therefore, Appellants respectfully request that the rejection under 35 U.S.C. §102(e) to claims 1, 6, 11, and 16 be reversed.

Ground of Rejection II:

35 U.S.C. §103(a) rejection of claims 2-3, 5 and 15

Claims 2, 3, 5, and 15 are rejected under 35 U.S.C. §103(a) as unpatentable over Leone in view of Bishop. As a threshold matter, a *prima facie* rejection has not been properly set forth for these claims. Cites to Bishop are not proper, as this reference is not prior art. Bishop is a Patent Publication with a filing date of December 9, 2004. The present application was filed December 26, 2001.

In the Final Office Action, the Office notes that the issue was not specifically raised in the Response when the reference was initially cited. The Office appears to assert that this fact transforms Bishop into prior art. Appellants are not aware of legal precedent for such an assertion, and respectfully request that the Examiner cite such precedent. Appellants also note that grounds of rejection for which Bishop was initially raised were withdrawn.

To set forth a proper *prima facie* case, a cite to actual prior art is required. While Bishop is a CIP to a number of earlier patents, the only proper citation is to a parent with an earlier priority date, and in which a cited limitation is found. Appellants respectfully request that the rejections to claims 2, 3, 5, and 15 under 35 U.S.C. §103(a) be reversed on these grounds as well.

Claims 2, 3, and 5 depend from independent claim 1, which is allowable for the reasons given above. Claim 15 depends from independent claim 11, which is allowable for the reasons given above. Claims 2, 3, 5, and 15 are therefore also allowable for at least the reason

that they depend from an allowable base claim. Therefore, Appellants respectfully request that the rejection under 35 U.S.C. §103(a) to claims 2, 3, 5, and 15 be reversed on these grounds, as well.

Ground of Rejection III:

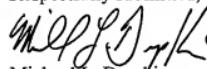
35 U.S.C. §103(a) rejection of claims 4, 7-10, and 12-14

Claims 4 and 7-10 are rejected under 35 U.S.C. §103(a) as unpatentable over Leone and in view of Klingman. Claims 4 and 7-10 depend from independent claim 1, which is allowable for the reasons given above. Claims 4 and 7-10 are therefore also allowable for at least the reason that they each depend from an allowable base claim. Therefore, Appellants respectfully request that the rejection under 35 U.S.C. §103(a) to claims 4 and 7-10 be reversed on these grounds.

8. CONCLUSION

For these reasons, it is respectfully submitted that the grounds of rejection should each be reversed.

Respectfully submitted,



Michael L. Drapkin
Reg. No. 55,127

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422
61108373 v1

9. CLAIMS APPENDIX

1. (Previously Presented) A method for auditing forms, the method comprising:
 - issuing a request to provide a form identifier that is associated with a form;
 - receiving the identifier at a host computer; and
 - verifying with the host computer whether the identifier is a valid identifier for the form being used.
2. (Previously Presented) A method as in claim 1, wherein the request is issued from a terminal having a processor that is in communication with the host computer, and further comprising logging an error if the identifier is not valid.
3. (Original) A method as in claim 2, wherein the request is sent from the host computer to the terminal.
4. (Original) A method as in claim 1, where the request is issued from a customer service operator over a phone.
5. (Original) A method as in claim 2, wherein the identifier is received at the host computer from the terminal.
6. (Original) A method as in claim 1, wherein the host computer includes an associated database, and wherein the identifier is verified by comparing the identifier with a list of valid identifiers in the database.
7. (Original) A method as in claim 1, further comprising determining whether an appropriate form has already been ordered.
8. (Original) A method as in claim 7, wherein if an appropriate form has not been ordered, placing an order for an appropriate form.

9. (Original) A method as in claim 8, further comprising evaluating whether the ordered form is received by a user.

10. (Original) A method as in claim 9, further comprising transmitting an identifier for a replacement form to the host computer.

11. (Original) A forms auditing system, comprising:
a host computer; and
a database associated with the host computer, the database having a record of a set of forms and a valid identifier for each of the forms;
wherein the host computer is configured to receive an identifier in response to a request to audit a form, and to verify whether the identifier is a valid identifier for the audited form by comparing the identifier with the identifiers in the database, and to produce a record in the database of the comparison.

12. (Original) A system as in claim 11, further comprising a terminal having a processor, wherein the terminal is configured to receive the identifier of the form being audited and to electronically send the identifier to the host computer.

13. (Original) A system as in claim 12, wherein the terminal is configured to produce an audit screen having a region for inputting the identifier.

14. (Original) A system as in claim 13, wherein the terminal is configured to produce the audit screen based on information sent to the terminal from the host computer.

15. (Original) A system as in claim 11, wherein the host computer is configured to generate an error report if the identifier of the form being audited is not valid.

16. (Previously Presented) A forms auditing system, comprising:
a form identifier that is associated with a form;
a host computer; and

a database associated with the host computer, the database having a record of a set of forms and a valid form identifier for each of the forms;

wherein the host computer is configured to receive the form identifier in response to a request to audit a form, and to verify whether the form identifier is a valid form identifier for the form to be audited by comparing the form identifier with the valid form identifiers in the database, and to produce a record in the database of the comparison.

10. EVIDENCE APPENDIX

None.

11. RELATED PROCEEDINGS APPENDIX

None.

61108373v1